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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,160	11/29/2001	Sumio Kuroda	1100.66020	3617

7590 06/23/2005

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,160

Applicant(s)

KURODA, SUMIO

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 June 2005 has been entered.

2. Claims 1-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 02 September 2003.

Claims 20-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 20-25 are directed to a method for manufacturing a substrate of a recording medium, whereas the originally examined claims are drawn to a substrate of recording medium. These inventions are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to

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make other and materially different product or (2) that the product as claimed can be made by another and materially different process. MPEP § 806.05(f). In the instant case, the product as recited can be made by another and materially different process such as without the use of a carbon mold.

Note, while claims 17-19 recite limitations as to how the product is manufactured, these limitations are not germane to the patentability of the recited product. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); MPEP § 2113.

Because Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is noted that Applicant in the remarks filed with the response of 13 June 2005 attempts to elect claims 20-25 for prosecution, arguing that with the filing of an RCE the election of these claims is permitted. The claims originally presented, however, and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in

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any request for continued examination (RCE) which has been filed for the application. MPEP 818.02(a). As claims 17-19 have been examined in the instant application, Applicant cannot now switch to the newly claimed invention by filing an RCE in the application.

Applicant's arguments that the inventions of claims 17-19 and claims 20-25 should be examined together are noted, but not found persuasive. The inventions are distinct as described above, and require fundamentally different considerations and searches to determine patentability. For example, the manner in which the substrate is made is irrelevant to the substrate product claims, but a valid consideration in a method of making the substrate claims. There would therefore be an undue burden on the Office to examine both inventions together, and thus, restriction is proper.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narumi et al. (U.S. Pat. No. 6,031,800; previously of record) in view of Medower et al. (U.S. Pat. No. 6,656,392; previously of record).

Narumi discloses a known optical disk substrate (see Fig. 27). The disk comprises a glass layer (2301) and an information pattern formed on the surface of the glass layer (cl. 1, ll. 16-19). The pattern is formed having concave and convex shapes (see Fig. 27).

Narumi discloses that the information pattern on the glass layer may provide "address or other information." Narumi does not explicitly disclose that the "other information" includes servo information. Medower, however, discloses that it is known in the art that optical disks can be provided with different

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information patterns, including address or servo information (cl. 3, ll. 52-62). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the substrate disclosed by Narumi as such to have servo information because this would type of information is known in the art to be useful on optical disks, and moreover, Narumi notes that other types of information may be formed on the disk substrate.

Claims 17-19 recite many limitations directed at how the claimed substrate is produced using a carbon mold. As noted above, the determination of patentability of a claimed product is determined by the product itself. The patentability of a product does not depend on its method of production. In the instant case, Narumi and Medower disclose and suggest, regardless of its method of production, a substrate with all of features of the claimed product substrate. Narumi and Medower therefore render obvious the claimed substrate regardless of the recited process of manufacture.

6. Applicant's arguments filed 13 June 2005 have been fully considered but they are not persuasive.

Applicant argues that it would not be obvious to combine the teachings of Narumi with Medower. Specifically, Applicant

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argues that Medower does not disclose the formation of information in the guide grooves of the substrate, but rather formation of address information on a separate data layer.

Applicant's argument is not found persuasive as the rejection is based on the combination of the references, rather than the individual disclosures of the references. Pointing out the differences between the reference and each individual reference is not sufficient to overcome a rejection based on a combination of references. One cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, the primary reference of Narumi itself notes that the optical disk may include "pits indicating address or other information" (cl. 1, ll. 17 and 18, emphasis added). The secondary reference of Medower is cited as showing that servo information is but another type of information that one of ordinary skill in the art would know is applicable with optical disks. That Medower discloses a different disk structure does not render the modification of Narumi to include servo information unobvious, as the primary reference of Narumi itself suggests that different information known in the art may be used with the

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substrate. In other words, Medower can be looked to by one of ordinary skill in the art as merely indicative of known alternative information patterns based on the disclosure of Narumi.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Donald Heckenberg', is written over the printed name.

Donald Heckenberg
Patent Examiner
A.U. 1722

6-21-5